

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Art Unit : 2834
Examiner : Joseph Waks
Applicant : Steve Anderson Platt
Appln. No. : 09/981,231
Filing Date : October 17, 2001
Conf. No. : 5580
For : WIND POWERED GENERATOR

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Commissioner for Patents
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APPELLANT'S REQUEST FOR RECONSIDERATION (37 CFR §41.52)

This brief is in furtherance of the Decision of the Board and Patent Appeals and Interferences issued on May 19, 2006.

This request for reconsideration contains these items under the following headings, and in the order set forth below:

- I. Status of Claims
- II. The Board's Decision
- III. Issues
- IV. Arguments
- V. Conclusion

The final page of this brief bears the attorney's signature.

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I. Status of Claims

Claims 1-37 and 39-74 are pending in this application. Claims 1-8, 11-14, 20-23, 29-37, 40, 46-49, 58-71 and 73 are allowed. The Examiner's rejection of claims 9, 10, 15-17, 24, 25, 42, 44, 45, 50-57, 72 and 74 was reversed such that claims 9, 10, 15-17, 44, 45, 50-57, 72 and 74 are now allowed and claims 24, 25 and 42 (which were all dependent claims) are in condition for allowance. Claims 18, 19, 26-28, 39, 41, 43 and 71 are the subject of this request for reconsideration.

II. The Board's Decision

Rejections Not Sustained

The rejection of claims 9, 10, 15, 17 and 24 as being rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,311,434 to Abe (hereinafter referred to as "the Abe '434 patent") was not sustained.

The rejection of claims 16 and 25 as being rejected under 35 U.S.C. §103(a) as being unpatentable over the Abe '434 patent in view of U.S. Patent No. 6,239,507 to Douthit (hereinafter referred to as "the Douthit '507 patent") was not sustained.

The rejection of claims 42, 44, 45, 50, 52 and 54-56 as being rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,110,631 to Salter (hereinafter referred to as "the Salter '631 patent") in view of the Abe '434 patent was not sustained.

The rejection of claim 51 as being rejected under 35 U.S.C. §103(a) as being unpatentable over the Salter '631 patent in view of the Abe '434 patent and U.S. Patent No. 6,239,507 to Douthit (hereinafter referred to as "the Douthit '507 patent") was not sustained.

The rejection of claim 53 as being rejected under 35 U.S.C. §103(a) as being unpatentable over the Salter '631 patent in view of the Abe '434 patent and the Barnes '631 patent was not sustained.

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The rejection of claim 57 as being rejected under 35 U.S.C. §103(a) as being unpatentable over the Abe '434 patent in view of U.S. Patent No. 5,244,346 to Fergusson (hereinafter referred to as "the Fergusson '346 patent") was not sustained.

The rejection of claims 72 and 74 as being rejected under 35 U.S.C. §103(a) as being unpatentable over the Abe '434 patent in view of the Barnes '631 patent was not sustained.

Rejections Sustained

The rejection of claims 18, 19, 26 and 71 as being rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,311,434 to Abe (hereinafter referred to as "the Abe '434 patent") was sustained.

The rejection of claims 18 and 19 as being rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,278,198 to Willis et al. (hereinafter referred to as "the Willis et al. '198 patent") was sustained.

The rejection of claims 27 and 28 as being rejected under 35 U.S.C. §103(a) as being unpatentable over the Abe '434 patent in view of U.S. Patent No. 4,374,631 to Barnes (hereinafter referred to as "the Barnes '631 patent") was sustained.

The rejection of claims 39, 41 and 43 as being rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,110,631 to Salter (hereinafter referred to as "the Salter '631 patent") in view of the Abe '434 patent was sustained.

III. Issues

The issues are:

- Issue 1: Whether claims 18, 19, 26 and 71 are anticipated by the Abe '434 patent?
- Issue 2: Whether claims 18 and 19 are anticipated by the Willis et al. '198 patent?
- Issue 3: Whether claims 27 and 28 are unpatentable over the Abe '434 patent in view of the Barnes '631 patent?

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Issue 4: Whether claims 39, 41 and 43 are unpatentable over the Salter '631 patent in view of the Abe '434 patent?

IV. Arguments

Issue 1: Whether claims 18, 19, 26 and 71 are anticipated by the Abe '434 patent?

Argument: In order to anticipate the invention as claimed, all elements must be found in a single reference. *Studiengesellschaft Kohle v. Dart Indus.*, 762 F.2d 724 (Fed. Cir. 1984). Applicant submits that neither the Board nor the Examiner has created a prima facie case of anticipation to reject claims 18, 19, 26 and 71 over the Abe '434 patent.

Discussion:

Claims 18, 19, 26 and 71 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated over the Abe '434 patent. While agreeing with Applicant that the Examiner's rejection as set forth in the final office action was incorrect, the Board sustained the Examiner's rejection by stating that:

Abe discloses a vertical tower including a vertical elevator having a track 1a and a carriage 12 for movement along the track. Abe also discloses a wind powered generator including airfoils 5 and an electric generator within the nacelle 2. Finally, Abe discloses that the wind powered generator can be removably placed within the mount 12 (placed on seat 15 to slide along rails 16) after the tower has been erected and wherein the wind powered generator can be removed from the mount 12 after the carriage has been lowered.

However, Applicant submits that the Abe '434 patent does not disclose a wind powered generator that can be removably placed within the carriage after the tower has been erected and that can be removed from within the carriage after the carriage has been lowered. According to the Board, the Abe '434 patent discloses a wind powered generator that can be "placed on seat 15 to slide along rails 16." (emphasis added). Applicant submits that placing a wind powered generator on rails is not placing a wind powered generator within a carriage. While the Abe '434 patent may disclose placing a wind powered generator on rails, the wind powered

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generator is not within the rails 16. Furthermore, the Abe '434 patent does not disclose a wind powered generator that can be removed from within the carriage after the carriage has been lowered. Accordingly, Applicants submit that claim 18 is in condition for allowance.

Claims 19, 26 and 71 depend from claim 18, and since claim 18 defines unobvious patentable subject matter, claims 19, 26 and 71 define patentable subject matter. Accordingly, claims 19, 26 and 71 are in condition for allowance.

Claims 18, 19, 26 and 71 are allowable over the Abe '434 patent, and the Board is requested to reverse the rejection of these claims.

Issue 2: Whether claims 18 and 19 are anticipated by the Willis et al. '198 patent?

Argument:

In order to anticipate the invention as claimed, all elements must be found in a single reference. *Studiengesellschaft Kohle v. Dart Indus.*, 762 F.2d 724 (Fed. Cir. 1984). Applicant submits that neither the Board nor the Examiner has created a prima facie case of anticipation to reject claims 18 and 19 over the Willis et al. '198 patent.

Discussion:

Claims 18 and 19 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated over the Willis et al. '189 patent. The Board sustained the Examiner's rejection by stating that:

Appellant's argument that Willis teaches that the wind turbine 16 can be removed from the carriage 32, but does not teach that the wind turbine can be removably placed within the carriage makes no sense. If the wind turbine 16 is on the carriage 32 and is removable, then it has to have been removably placed on the carriage. That is, it is removable from the carriage. (emphasis added)

However, Applicant submits that the Willis et al. '189 patent does not disclose a wind powered generator that can be removably placed within the carriage after the tower has been

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erected and that can be removed from within the carriage after the carriage has been lowered. According to the Board, the Willis et al. '189 patent discloses a wind powered generator that can be placed on the carriage. (emphasis added). Applicant submits that placing a wind powered generator on a carriage is not placing a wind powered generator within a carriage. While the Willis et al. '189 patent may disclose placing a wind powered generator on a carriage, the wind powered generator is not within the carriage. Furthermore, the Willis et al. '189 patent does not disclose a wind powered generator that can be removed from within the carriage after the carriage has been lowered. Accordingly, Applicants submit that claim 18 is in condition for allowance.

Claim 19 depends from claim 18, and since claim 18 defines unobvious patentable subject matter, claim 19 defines patentable subject matter. Accordingly, claim 19 is in condition for allowance.

Claims 18 and 19 are allowable over the Willis et al. '189 patent, and the Board is requested to reverse the rejection of these claims.

Issue 3: Whether claims 27 and 28 are unpatentable over the Abe '434 patent in view of the Barnes '631 patent?

Argument:

In order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. §706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1586 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 550 (C.C.P.A. 1974). The burden is on the Examiner to create a *prima facie* case of obviousness, not on the Applicant to provide reasons for patentability. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

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Applicant submits that neither the Board nor the Examiner has created a *prima facie* case of anticipation or obviousness to reject claims 27 and 28 over the Abe '434 patent in view of the Barnes '631 patent.

Discussion:

Claims 27 and 28 depend from claim 18, and since claim 18 defines unobvious patentable subject matter, claims 27 and 28 define patentable subject matter. Accordingly, claims 27 and 28 are in condition for allowance.

Claims 27 and 28 are allowable over the Abe '434 patent in view of the Barnes '631 patent, and the Board is requested to reverse the rejection of these claims.

Issue 4: Whether claims 39, 41 and 43 are unpatentable over the Salter '631 patent in view of the Abe '434 patent?

Argument:

In order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. §706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1586 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 550 (C.C.P.A. 1974). The burden is on the Examiner to create a *prima facie* case of obviousness, not on the Applicant to provide reasons for patentability. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Applicant submits that neither the Board nor the Examiner has created a *prima facie* case of obviousness to reject claims 39, 41 and 43 over the Salter '631 patent in view of the Abe '434 patent.

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Discussion:

Claim 39 was rejected by the Examiner under 35 U.S.C. §102(b) as being unpatentable over the Salter '631 patent in view of the Abe '434 patent. The Board sustained the Examiner's rejection by stating that:

The (electric) generator of Salter is the drum 15 and its associated elements which produce electric power when the drum is sufficiently rotated. As can be seen in figure 1 of Salter, the drum 15 simply has to be in contact with each of the rims 13. We agree with the examiner that the electric power producing elements associated with the drum can be located upwind or downwind of the rotating spars and such location would have no effect of the functioning of the airfoils 19. In other words, the entire assembly of figure 1 is not turned around, but only the generator 15 would be moved to the other side of the rotating rotors 12. Thus, appellant's argument that the airfoils would become useless is not agreed with. Although we agree with appellant that the examiner's reason for moving the generator in Salter is not supported within the references, we agree, nevertheless, that the artisan would have recognized that the location of the generator 15 upwind or downwind of the spars would have no effect on the performance of the wind generator of Salter. (emphasis added)

However, Applicant submits that moving the generator to be upwind of the spars would effect the functioning and performance of the wind generator of the Salter '631 patent. The Salter '631 patent identifies element 16 as the electric generator. See line 6 of column 4. Therefore, in order to meet all of the elements of claim 39, the electric generator 16 of the Salter '631 patent would have to be moved in front of the drum 15 (as the drum 15 cannot be moved as it must always be in contact with the rims 13 of the rotors 12, although it could be rotated). Furthermore, in order for the system of the Salter '631 patent to generate electricity, the electric generator 16 has to be stationary relative to the drum 15. Therefore, if the electric generator 16 was moved in front of the drum 15 (as illustrated in FIG. 3 of the Salter '631 patent), there would be no support for the electric generator 16 to keep the electric generator 16 stationary. Accordingly, with the system as set forth by the Board, the generator of the

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Salter '631 patent would not be able to generate electricity. Therefore, Applicant submits that there is no suggestion or motivation for making such a modification.

Furthermore, the support 40 for the electric generator 16 has to be behind, or downwind, of the rotors 12. As described in lines 47-68 of column 5 and lines 1-30 of column 6 of the Salter '631 patent, as well as being illustrated in FIG. 8, the rotors 12, the support 40 for the electric generator 16 and the electric generator 16 move in a clockwise direction when the wind against the front of the rotors 12 becomes too great, such that the rotors are no longer directly in the wind (see FIG. 8). The movement is called "feathering." Feathering is required to prevent damage to the wind powered generator. As described in the portions of the Salter '831 patent as outlined above, the electric generator 16 and its support 40 need to be located behind the rotors 12 to allow the rotors 12 to feather properly and easily. If the electric generator 16 of the Salter '631 patent was positioned upwind of the rotors 12, the electric generator 16 would not be able to remain stationary and the rotors 12 would not be able to feather as taught by the Salter '631 patent. Therefore, Applicant submits that the modification as set forth by the Board would effect the performance of the wind powered generator of the Salter '631 patent. Accordingly, Applicant submits that there is no suggestion or motivation for making such a modification as set forth by the Board and that claim 39 is in condition for allowance.

Claims 41 and 43 depend from claim 39, and since claim 39 defines unobvious patentable subject matter, claims 41 and 43 define patentable subject matter. Accordingly, claims 41 and 43 are in condition for allowance.

Claims 39, 41 and 43 are allowable over the Salter '631 patent in view of the Abe '434 patent, and the Board is requested to reverse the rejection of these claims.

V. Conclusion

Each appealed claim is definite and recites features that are not disclosed by any of the cited references and it would not have been obvious to modify the cited references to include the

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recited features of the appealed claims. The references upon which the Board and the Examiner relies in their rejections of the finally rejected claims do not disclose or suggest a wind powered generator that can be removably placed within a carriage or a generator located upwind of spars. Applicant's invention resolves problems and inconveniences experienced in the prior art, and therefore represents a significant advancement in the art. Applicant earnestly requests that the Examiner's final rejection of claims 18, 19, 26-28, 39, 41, 43 and 71, inclusive, be reversed, and that the subject application be passed to issuance forthwith.

Respectfully submitted,

July 19, 2006

Date

MPD/msj

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